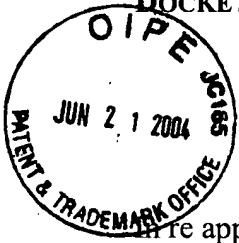


DOCKET No.: OFFW01-00008

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: : TROY ALAN USSERY ET AL.
Serial No. : 09/694,425
Filed : October 23, 2000
For : ELECTRONIC COMMERCE SYSTEMS FOR PROVIDING
COMMERCIAL INFORMATION VIA A GLOBAL
COMMUNICATIONS NETWORK AND METHODS OF
OPERATING THE SAME
Group No. : 3677
Examiner : Dinesh Melwani

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANTS'S BRIEF UNDER 37 C.F.R. § 1.192

This brief is in furtherance of the Notice of Appeal filed in this application on March 18, 2004. The fees required under 37 C.F.R. § 1.17(c), and a required petition for extension of time for filing this appeal brief and fees for the extension of time, are dealt with in the accompanying transmittal letter.

This brief is transmitted in triplicate (37 C.F.R. § 1.192(a)).

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This brief contains these items under the following headings, and in the order set forth below

(37 C.F.R. §1.192(c)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF INVENTION
- VI ISSUES
- VII GROUPING OF CLAIMS
- VIII ARGUMENTS
 - A. ARGUMENTS – REJECTION OF CLAIMS 1-5, 8-15 AND 18-20 UNDER
35 U.S.C. § 103.
 - B. ARGUMENTS – REJECTION OF CLAIMS 6, 7, 16 AND 17 UNDER
35 U.S.C. § 103.
- IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of this brief before the beginning of the Appendix of Claims bears the attorney's signature.

I REAL PARTY IN INTEREST (37 C.F.R. § 1.192(c)(1))

The real party in interest in this appeal is Business-To-Investor, Inc. as indicated by an assignment of Patent Application Serial No. 09/694,425 recorded on October 23, 2000 in the Assignment Records of the United States Patent and Trademark Office (Reel 011327, Frame 0016).

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

There are twenty (20) claims in the application (Claims 1-20).

B. STATUS OF ALL THE CLAIMS

1. Claims previously canceled: None.
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: Claims 1-20.
4. Claims allowed: None.
5. Claims rejected: Claims 1-20.

C. CLAIMS ON APPEAL

There are twenty (20) claims on appeal. The claims are Claims 1-20.

IV STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

Claims 1-20 were finally rejected in the Office Action of January 13, 2004. No amendments were submitted and refused entry after issuance of the final Office Action of January 13, 2004.

V SUMMARY OF INVENTION (37 C.F.R. § 1.192(c)(5))

The Appellants' invention comprises an apparatus and method for operating an electronic commerce system. The electronic commerce system 100 of the present invention is designed for use with a global communication network 115 having company nodes 105 and a plurality of constituency nodes 110. The electronic commerce system 100 of the present invention comprises a data repository 125 that is operable to store data files associated with the company nodes 105 wherein the company nodes 105 populate respective associated data files with company information. The electronic commerce system 100 of the present invention also comprises a communications controller 120 that is operable to (i) propagate communication interfaces accessible by the constituency nodes 110 with selected portions of company information under the direction of the company nodes 105, and (ii) gather feedback information representative of constituency response to the constituency nodes 110 that access the communication interfaces. (Specification, Page 16, Line 19 to Page 18, Line 5).

VI ISSUES (37 C.F.R. § 1.192(c)(6))

- A. Whether Claims 1-5, 8-15 and 18-20 are unpatentable under 35 U.S.C. § 103(a) as being obvious in view of United States Patent No. 6,393,410 issued to *Thompson*.
- B. Whether Claims 6, 7, 16 and 17 are unpatentable under 35 U.S.C. § 103(a) as being obvious over *Thompson* in view of United States Patent No. 5,729,694 to *Holzrichter et al.* (hereafter, "*Holzrichter*").

VII GROUPING OF CLAIMS (37 C.F.R. § 1.192(c)(7))

For purposes of this appeal, the pending claims will be grouped together as follows:

Group A Claims 1-5, 8-15 and 18-20.

Group B Claims 6, 7, 16 and 17.

Patentability of the claims within each group is argued separately below.

VIII ARGUMENTS

- A. ARGUMENTS – Rejection of Claims 1-5, 8-15 and 18-20 under 35 U.S.C. § 103(a) (37 C.F.R. § 1.192(c)(8)(iv)):

In the Office Action of January 13, 2004 the Examiner rejected Claims 1-5, 8-15 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over the *Thompson* reference.

Section 103(a) provides that "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between

the subject matter sought to be patented and the prior art of such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the Appellants to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Appellants is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference (or references when combined) references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on Appellants' disclosure. MPEP § 2142.

The Applicants acknowledge that the teachings of *Thompson* are broadly directed to an electronic commerce system for use over a global communications network, such as the Internet. In particular, *Thompson* is directed to a process for estimating construction projects over the global network. The *Thompson* construction bidding scheme enables a party controlling a construction project to post a request for a proposal for all or a portion of the construction project. In the *Thompson* system the information relating to the construction projects is sold to purchasers who request the information.

“System host 15 runs a program that controls the process for displaying quantities, estimates, bids, project schedules, and shop drawings on construction projects stored in the database 30 over the computer network. Through a series of remote computers, a series of different purchasers can log into server 10 to review these construction projects and to purchase information relating to these construction projects on web-pages 35.” (*Thompson*, Column 2, Lines 45-52).

“Next, in step 240 the purchaser agrees to purchase this project wherein the purchaser is next directed to step 250 to enter in the purchaser's purchasing information in a webpage shown in FIG.9.” (*Thompson*, Column 4, Lines 3-6). “Next, in step 260 the purchaser downloads the information that he or she purchased. Essentially the information purchased by the user is

either quantities, estimates, bids, project schedules, or shop drawings.” (*Thompson*, Column 4, Lines 12-15).

Therefore, in contrast to the present invention, the *Thompson* system sells information to purchasers. Using the purchased information, the purchasers (e.g., contractors, sub-contractors) may or may not submit responses that relate to the construction project in question. The responses may respond completely or incompletely. According to *Thompson*, the controlling party (or some agent thereof) may have supervisory control over acceptance or rejection of the response (or portions thereof) that is received from the purchaser of the construction project information.

In the system described by *Thompson* the information that is purchased by the purchasers is owned by the purchasers. Therefore, the information is not subject to further control or modification by the controlling party who sold the information to the purchasers.

One of the broadest claims in this Application is Claim 1, which reads as follows:

1. For use over a global communications network having company nodes and constituency nodes associated therewith, an electronic commerce system comprising:

a data repository that is operable to store data files associated with said company nodes, wherein said company nodes populate respective associated data files with company information; and

a communications controller that is operable to (i) propagate communication interfaces accessible by said constituency nodes with selected portions of said company information under direction of said company nodes, and (ii) gather feedback information representative of constituency response to said constituency nodes accessing said communication interfaces. (Emphasis added).

The *Thompson* references does not provide, teach or suggest the Applicants’ electronic commerce system having (i) a data repository populated with company information by the company nodes, nor (ii) a communications controller operable to propagate communication interfaces

accessible by constituency nodes with selected portions of the company information under direction of the company nodes, or to gather feedback information representative of constituency response to the constituency nodes accessing said communication interfaces.

As set forth in the Summary of the Invention of this Application, a primary object hereof is to provide an electronic commerce system for monitoring communication of information by a company node to constituency nodes and analyzing constituency understanding and reaction to such information communication. The communications controller (and associated data repository), advantageously provide an interactive system that enables the company to generate and near-continuously communicate company information to its constituency via the global communications network. The company information in the present invention is not sold to purchasers. The company information is owned by the company. The company information is therefore subject to further control or modification by the company's authorized representatives.

An important aspect of the present invention is the ability of the company node to control when publication (*e.g.*, to fairly disseminate, distribute or otherwise make available) of at least selected portions of the company information stored in the data repository is available to the constituencies. This may advantageously be accomplished through the communications controller. In the *Thompson* system the distribution of information occurs only after the information has been paid for by a purchaser. The *Thompson* system operates as a sales tool for selling information.

Further, the only way one can arrive at the present invention is by looking backward from *Thompson* at the Appellants' invention. It cannot be said that one of ordinary skill in the pertinent art would be presumed to know of the teachings of *Thompson* and could solve the same or a similar

problem as that addressed by the Appellants. *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 906-07, 225 U.S.P.Q. 20, 25 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985); *In re Sernaker*, 702 F.2d 989, 995, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983). The requisite motivation does not stem from any of these teachings, from the perspective of one of ordinary skill in the art, to arrive at the Appellants' invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

The *Thompson* references does not provide, teach or suggest the Applicants' electronic commerce system having as recited in Claim 1 (and Claims 2-5 and 8-10 depending from Claim 1). In relation to the differences between Claim 1 and *Thompson*, Claims 11 and 20 may be said to include analogous limitations to those found in Claim 1, and, as such, are also not taught, suggested, or hinted at by the *Thompson* reference (and Claims 12-15, 18 and 19 depending from Claim 11).

Simply stated, Claims 1-5, 8-15 and 18-20 are not *prima facie* obvious. Therefore the Appellants therefore respectfully submit that Claims 1-5, 8-15 and 18-20 are not obvious under 35 U.S.C. § 103(a) in view of the *Thompson* reference. For the foregoing reasons, the Applicants respectfully request withdrawal of the § 103(a) rejection of Claims 1-5, 8-15 and 18-20.

B. ARGUMENTS - Rejection of Claims 6, 7, 16 and 17 under 35 U.S.C. § 103(a)
(37 C.F.R. § 1.192(c)(8)(v)):

In the Office Action of January 13, 2004 the Examiner rejected Claims 6, 7, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Thompson* in view of United States Patent No. 5,729,694 issued to *Holzrichter*.

The Appellants hereby incorporate by reference all of the arguments previously made in connection with Appellants' position that Claims 1-5, 8-15 and 18-20 are patentable.

As described in the previous section of this Appeal Brief, Claims 1 and 11 are patentable over the cited art. As a result, Claims 6, 7, 16 and 17 are patentable due to their dependence from allowable base claims. Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection of Claims 6, 7, 16 and 17.

Further, the Appellants respectfully traverse the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by *Thompson* to utilize the speaker identification teachings as taught by *Holzrichter*.

First, the supposed motivation to provide the *Thompson* system with "the capability of being accessed by those denied the use of their hands" is very general and does not specifically suggest combining the teachings of the *Thompson* reference with the teachings of the *Holzrichter* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to obtain "the capability of being accessed by those denied the use of their hands" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Holzrichter* does not disclose or even hint at the steps of the method claimed in independent Claim 1 from which Claim 6 indirectly depends.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish

obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Appellants respectfully submit that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Appellants respectfully submit that the alleged motivation to combine references is not clear and particular. The Examiner stated that “It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Holzrichter, in regards to speaker identification, language-of-speech identification, and speech translation, provide Thompson’s systems with the capability of being accessed by those denied the use of their hands and thereby precluded from using a conventional computer terminal .” (January 13, 2004 Office Action,

Page 4, Lines 4-9). The Appellants respectfully traverse this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Appellants respectfully submit that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Appellants’ invention.

Even if the *Holzrichter* reference could somehow be combined with the *Thompson* reference, the combination would not teach, suggest, or even hint at the Appellants’ invention as set forth in Claims 6, 7, 16 and 17. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an Appellants’ disclosure. In the present case, the *Thompson* reference and the *Holzrichter* reference in combination would not teach or suggest all the claim limitations of Claims 6, 7, 16 and 17 of the Appellants’ invention.

For the foregoing reasons, the Appellants respectfully assert that the final rejection of Claims 1-20 in the January 13, 2004 Office Action was improper. The Appellants respectfully request that the final rejection of Claims 1-20 be withdrawn and that Claims 1-20 be allowed.

SUMMARY

For the reasons given above, the Appellants respectfully request reconsideration and allowance of the claims and that this patent application be passed to issue.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: June 17, 2004

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IX APPENDIX OF CLAIMS INVOLVED IN THE APPEAL (37 C.F.R. §1.192(c)(9))

The text of each claim involved in the appeal is as follows:

1. For use over a global communications network having company nodes and constituency nodes associated therewith, an electronic commerce system comprising:

a data repository that is operable to store data files associated with said company nodes, wherein said company nodes populate respective associated data files with company information; and

a communications controller that is operable to (i) propagate communication interfaces accessible by said constituency nodes with selected portions of said company information under direction of said company nodes, and (ii) gather feedback information representative of constituency response to said constituency nodes accessing said communication interfaces.

2. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller is further operable to process said gathered feedback information and, in response thereto, modify ones of said data files.

3. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller is further operable to analyze said gathered feedback information and ones of said data files and, in response thereto, to report results thereof to said company node.

4. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller, while gathering said feedback information, employs mathematical representations to represent at least one of constituency understanding and constituency reaction.

5. The electronic commerce system for use over a global communications network recited in Claim 1 further comprising a security controller that is operable, with respect to those data files associated with said company node, to limit access to said those data files to designated personnel of said company nodes.

6. The electronic commerce system for use over a global communications network recited in Claim 5 wherein said security controller includes an interactive voice recognition controller that is operable to verify the identity of said designated personnel.

7. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller is further operable to translate said selected portions of said company information from a first language into a second language.

8. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller is further operable to store, index and relate associated portions of said company information in the data repository.

9. The electronic commerce system for use over a global communications network recited in Claim 1 wherein said communications controller is further operable to organize said selected portions of said company information that propagate said communication interfaces into channels accessible by said constituency nodes.

10. The electronic commerce system for use over a global communications network recited in Claim 9 wherein said channels include at least two of an overview channel, an outlook channel, a community consensus channel, a community forecast channel, a research channel, an online q&a channel, an online conference channel, a financial history channel and a newsroom channel.

11. For use over a global communications network having company nodes and constituency nodes associated therewith, a method of operating an electronic commerce system having a data repository and a communications controller, said method of operation comprising:
storing data files associated with said company nodes in said data repository, wherein said company nodes populate respective associated data files with company information;
propagating communication interfaces accessible by said constituency nodes with selected portions of said company information using said communications controller under direction of said company nodes; and
gathering feedback information with said communications controller, said feedback information representative of constituency response to said constituency nodes accessing said communication interfaces.

12. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the steps of processing said gathered feedback information and, in response thereto, modifying ones of said data files.

13. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the steps of analyzing said gathered feedback information and ones of said data files and, in response thereto, reporting results thereof to said company node.

14. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the step of, while gathering said feedback information, employing mathematical representations to represent at least one of constituency understanding and constituency reaction.

15. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the step of limiting, with respect to those data files associated with said company node, access to said those data files to designated personnel of said company nodes.

16. The method of operating the electronic commerce system for use over a global communications network recited in Claim 15 wherein said limiting access step further comprises the step of using an interactive voice recognition controller to verify the identity of said designated personnel.

17. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the step of translating said selected portions of said company information from a first language into a second language.

18. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the steps of storing, indexing and relating associated portions of said company information in the data repository.

19. The method of operating the electronic commerce system for use over a global communications network recited in Claim 11 further comprising the step of organizing said selected portions of said company information that propagate said communication interfaces into channels accessible by said constituency nodes.

20. For use over a global communications network having company nodes and constituency nodes associated therewith, an electronic commerce system comprising:

a data repository that is operable to store data files associated with said company nodes, wherein said company nodes populate respective associated data files with company information; and

a communications controller that is operable to:

propagate communication interfaces accessible by said constituency nodes with selected portions of said company information under direction of said company nodes,

gather feedback information representative of constituency response to said constituency nodes accessing said communication interfaces,

process and analyze said gathered feedback information and, in response thereto, to at least one of modify ones of said data files and report results thereof to said company node, and

limit access, with respect to those data files associated with said company node, to designated personnel of said company nodes.